

REMARKS/ARGUMENTS

Reconsideration of this application is respectfully requested in view of the foregoing amendments and the following remarks.

Claims 1-78 remain pending and have been rejected. Claims 19, 22, 25, 45, and 55 have been amended.

With regard to the requirement to amend the drawings submitted on July 1, 2004, "because the drawings include handwritten numerals," it is believed that the examiner is in error. Exhibit A is a copy of the drawings from the image file wrapper of the current application that were filed on July 1, 2004. From a careful review of these drawings, there are no handwritten numerals or other informalities that require amendment. Because the requirement for amended drawings was made in error, it is believed that no amendments were needed based on examiner error. If the examiner determines that an extension of time fee is due for this response to be considered timely, then the examiner is authorized to charge our deposit account 50-1903 with a one month extension of time fee.

With regard to the provisional double patenting rejections in view of co-pending application serial number 10/798,677 alone or in combination with other references, the examiner is requested to hold these rejections in abeyance until allowable subject matter has been indicated in either the present application or application serial number 10/798,677.

The examiner has rejected claims 19, 22, 25, 45, and 55 under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. This rejection as it applies to the amended claims is traversed.

Claims 19, 22, 25, 45, and 55 have been amended to indicate that the structure is "adapted to be removably attached" to the underlying structure. Because there is direct recitation of the human body in the amended claims, this rejection has been overcome and should be withdrawn.

The examiner has rejected claims 1-8, 13, 14, 24, 27-32, 37, 43, and 56-62 under 35 U.S.C. §102(b) as anticipated by U. S. Patent No. 6,390,982, Bova et al., hereafter "the '982 patent." This rejection is traversed.

In order to anticipate a claim, the cited document must disclose each and every limitation of the rejected claim. The '982 patent fails to disclosed all elements of the above listed claims. In particular, the '982 patent fails to disclose "a substrate capable of being removably mounted to an outer surface of a body." The examiner indicated in the office action that item 24 in FIG. 2 the '982 patent discloses the quoted language. There is no structure disclosed or even suggested in the '982 patent to enable substrate 24 of the '982 patent to be "removably mounted to an outer surface of a body" as recited in independent claims 1, 24, 39, or 56. Substrate 24 is mounted to the ultrasound device 22 that is merely placed in contact with the body. The word "mounted" in claims 1 and 24 is defined in Webster's New World College Dictionary, Fourth Edition as "to place, fix or fasten on or in the proper support, etc. for the required purpose." See the copy attached as Exhibit B. Clearly the word "mounted," especially when used in the phrase "mounted to" means that the substrate must be somehow fixed to the underlying structure. Placing an ultrasound device on the body would never be considered as being mounted to the body by those of ordinary skill in the art. In addition, the substrate and markers 26 are there to locate the ultrasound device 22. This is needed because the ultrasound device is movable relative to the body and needs to be precisely located. There is no mounting structure disclosed or suggested by the '982 patent. The ultrasound device 22 does not mount the substrate 24 to the body, substrate 24 is attached to the ultrasound device to locate that device not the body structure. Therefore, there is no disclosure of a "substrate capable of being removably mounted to an outer surface of the body." For this reason, the rejection is unwarranted and should be withdrawn.

The examiner has also rejected claim 25 under 35 U.S.C. §103(a) as unpatentable over the '982 patent in view of U. S. Patent Publication No. 2004/97807, Smith et al., hereafter "the '807 publication." This rejection is traversed.

The '807 publication does disclose hydrogels that have an adhesive nature. However, the '807 publication discloses these materials for use in fixing membranes to the patient so that the ultrasound device that is freely passed over these membranes will properly receive an image. The '982 patent fails to disclose mounting of a substrate to a body and the '807 publication does not remove this inherent deficiency of the '982 patent. Therefore, the continued rejection of claim 25 is unwarranted and should be withdrawn.

The examiner has rejected claim 26 under 35 U.S.C. §103(a) as unpatentable in view of the '982 patent alone. This rejection is traversed.

As noted above the '982 patent failed to disclose or suggest the subject matter of claims 26. The size set out in claim 26 shows the relatively small size of the structure and the fact that it can be affixed to the patient in a relatively unobtrusive and non-invasive fashion. Therefore, this claim should be allowable.

The examiner has also rejected claims 15-18, 20, 47-54, 70-73, and 75 under 35 U.S.C. §103(a) as unpatentable in view of the '982 patent in view of U. S. Patent No. 5,321,257, Danisch, hereafter "the '257 patent." This rejection is traversed.

The '982 patent does not contemplate the use of fiber optic devices to sense position. There is no reason one of ordinary skill would modify an ultrasound device of the '982 patent to the fiber optic devices of the rejected claims without having reference to the instant application. To suggest that somehow the combination of the totally unrelated '982 patent and the '257 patent would have been obvious to one of ordinary skill relies totally on a hindsight reconstruction based on the template of the present application. This is not permissible. The motivation cited by the examiner in the '257 patent does not provide any reason for one of ordinary skill to combine these documents in the manner done by the examiner. Therefore, this rejection is unwarranted and should be withdrawn.

The examiner has also rejected claims 21, 23, 44-46, 76, and 78 under 35 U.S.C. §103(a) as unpatentable in view of the '982 patent in view of U. S. Patent No. 6,073,043, Schneider, hereafter "the '043 patent." This rejection is traversed.

As with the discussion relative to the fiber optic devices, the '982 patent does not admit to the substitution of other devices for the ultrasound device. The motivation noted by the examiner does not negate the hindsight reconstruction of the invention as claimed. This is a statement of the advantages of the system of the '043 patent and does not provide any rationale for the substitution advanced by the examiner.

The examiner has also rejected claims 19, 22, 55, 74, and 77 under 35 U.S.C. §103(a) as unpatentable in view of the '982 patent in view of the '257 patent, further in view of the '043 patent and U. S. Patent No. 5,441,502, Bartlett, hereafter "the '502 patent." This rejection is traversed.

The '502 patent does not remove any of the weakness of the examiner's rejections based on the '982, '257 and '043 patents discussed above. In fact it further reinforces applicant's contention that this rejection is a hindsight reconstruction based on the present application. The '982 patent discloses the use of pins to affix the device 14 to the patient. However, to suggest that the device to determine the internal structure position would be attached by pins is not suggested in the combination cited by the examiner. Therefore, this rejection is unwarranted and should be withdrawn.

The examiner has also rejected claims 63-66, 68, and 69 as unpatentable under 35 U.S.C. §103(a) over the '982 patent in view of U. S. Patent No. 6,356,782, Sirimanne et al., hereafter "the '782 patent." This rejection is traversed.

Claim 63 adds a method step to claim 56 where a position indicating device is placed next to the structure. In the '782 patent, the device is used to fill the void left after a biopsy has been taken. This has a dual purpose including the ability to later locate the biopsy region in follow on examinations. There is no disclosure or suggestion of the method of these rejected claims by the combination of the '982 and the '782 patents. Again, the examiner is stretching what a person of ordinary skill would consider obvious by combining these two documents. In viewing these two documents a person of ordinary skill would not think of the method of rejected claims without having the present application as a roadmap or template. Therefore, this rejection is unwarranted and should be withdrawn.

Lastly, the examiner has rejected claims 9-12, 33-36, and 67 under 35 U.S.C. §103(a) over the '982 patent in view of the '782 patent and U. S. Patent No. 6,405,072, Cosman, hereafter "the '072 patent."

In making this rejection the examiner is confusing the use of markers to locate external devices of the type disclosed in the '982 and '072 patents with internal markers. As noted above the '782 patent does not disclose the concept as claimed in the presently rejected claims. Furthermore, the '072 patent does not add any useful teaching to the combination of the '982 and '782 patents. Therefore, these claims should be allowed and any further rejection is unwarranted.

Reconsideration and allowance of the foregoing claims are respectfully requested.

Deposit Account Authorization

The Commissioner is hereby authorized to charge any deficiency in any amount enclosed or any additional fees, which may be required during the pendency of this application under 37 CFR 1.16 or 1.17, except issue fees, to Deposit Account No. 50-1903.

Respectfully submitted,

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